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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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23869	7590	12/28/2007		
HOFFMANN & BARON, LLP 6900 JERICHO TURNPIKE SYOSSET, NY 11791			EXAMINER ELEY, TIMOTHY V	
			ART UNIT 3724	PAPER NUMBER
			MAIL DATE 12/28/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/541,003

Applicant(s)

VAN BRUG ET AL.

Examiner

Timothy V. Eley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 15-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 9/28/05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

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## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election of claims 1-14 in the reply filed on November 20, 2007 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

### ***Oath/Declaration***

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:  
It incorrectly states that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56.

It should contain language similar to: I acknowledge the duty to disclose information which is material to patentability of this application in accordance with Title 37, Code of Federal Regulations Section 1.56.

### ***Specification***

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The claims are not directed to "an apparatus".

4. The disclosure is objected to because of the following informalities:

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- a. Applicant should provide headings throughout the specification, for example; "Brief Description of the Drawings".
- b. Applicant should not refer specifically to the claims throughout the specification, since the final number of the claims may be changed. See page 7, lines 22,25, and 26, for examples.
- c. Numeral "10"(page 11, line 23) is not seen in the drawings.
- d. Numeral "11"(page 11, line 26) should be --12--.
- e. Numerals "P1,P2"(page 14, line 5) are not seen in the drawings.
- f. Numerals "Z1,Z2"(page 14, line 6) are not seen in the drawings.
- g. Numerals "29A,29B"(page 15, line 18) are not seen in the drawings.
- h. Numeral "29B"(page 15, line 21) should be --30B--.
- i. Numeral "18"(figure 8) appears to be incorrect. Should it be numeral "16"?
- j. Numeral "53"(page 17, line 24) is not seen in the drawings.
- k. "(w)ith"(page 18, line 2) is misspelled.
- l. Numeral "19"(page 18, line 13) is not seen in the drawings.<sup>3</sup>  
Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. The following phrases in the claims are vague, indefinite, and/or awkwardly and confusingly worded and are therefore not fully understood:

- i. "apparatus . . . elements"(claim 1, lines 1 and 2).
- ii. "a working apparatus . . . technique"(claim 1, lines 2 and 3).
- iii. "said surface"(claim 1, line 4). This phrase is vague and indefinite since it lacks proper antecedent basis because it was not properly earlier referred to.
- iv. "in particular . . . scatterometry"(claim 2, lines 2 and 3).
- v. "in particular . . . substance"(claim 4, lines 4 and 5).
- vi. "the surface . . . holder"(claim 6, line 3). This phrase is vague and indefinite since it lacks proper antecedent basis because it was not properly earlier referred to.
- vii. "the opposite side"(claim 6, line 4). This phrase is vague and indefinite since it lacks proper antecedent basis because it was not properly earlier referred to.

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viii. "in the holder . . . lens" (claim 7, lines 1 and 2).

ix. "an apparatus . . . element" (claim 9, lines 2-end).

x. "wherein . . . device" (claim 14, lines 4-7).

#### **Conclusion**

7. The claims have not been further treated on the merits since they are vague, indefinite, and/or awkwardly and confusingly worded and are therefore not fully understood.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. The cited prior art discloses working apparatuses having measuring means.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy V. Eley whose telephone number is 571-272-4506. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer D. Ashley can be reached on 571-272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Timothy V Eley/  
Timothy V Eley  
Primary Examiner  
Art Unit 3724

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